

REMARKS

Applicant thanks the Examiner for the very thorough consideration given the present application.

Claims 1, 5, 6 and 10 are now present in this application. Claims 1 and 6 are independent.

Reconsideration of this application is respectfully requested.

Rejections under 35 U.S.C. § 103

Claims 1, 5, 6 and 10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the applied art in view of either U.S. Patent 6,396,177 to Shin et al. ("Shin") or U.S. patent 6,339,275 to Katagiri in view of U.S. Patent 4,115,716 to Ogasawala et al. ("Ogasawala"). This rejection is respectfully traversed.

A complete discussion of the Examiner's rejection is set forth in the Office Action, and is not being repeated here.

Because the rejection is based on 35 U.S.C. § 103, what is in issue in such a rejection is "the invention as a whole", not just a few features of the claimed invention. Under 35 U.S.C. § 103, "[a] patent may not be obtained . . . if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." The determination under section 103 is whether the claimed invention

as a whole would have been obvious to a person of ordinary skill in the art at the time the invention was made. See In re O'Farrell, 853 F.2d 894, 902, 7 USPQ2d 1673, 1680 (Fed. Cir. 1988). In determining obviousness, the Examiner must explain what the differences between the claimed invention and the prior art are and provide objective factual evidence to support a conclusion that it would be obvious to one of ordinary skill in the art to achieve the claimed invention, which includes those missing features.

In the second place, in rejecting claims under 35 U.S.C. § 103, it is incumbent on the Examiner to establish a factual basis to support the legal conclusion of obviousness. See, In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one of ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. F-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the Examiner are an essential part of complying with the burden of presenting a *prima facie* case of obviousness. Note, In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). The mere fact that the prior art may be modified in the

manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be suggested or taught by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1970). All words in a claim must be considered in judging the patentability of that claim against the prior art. In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

A showing of a suggestion, teaching, or motivation to combine the prior art references is an “essential evidentiary component of an obviousness holding.” C.R. Bard, Inc. v. M3 Sys., Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998). This showing must be clear and particular, and broad conclusory statements about the teaching of multiple references, standing alone, are not “evidence.” See In re Dembiczak, 175 F.3d 994 at 1000, 50 USPQ2d 1614 at 1617 (Fed. Cir. 1999).

Moreover, a factual inquiry whether to modify a reference must be based on objective evidence of record, not merely conclusory statements of the Examiner. See, In re Lee, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002).

Initially, Applicant does not understand why the Office Action continues to use multiple alternative references to serve as multiple separate grounds of rejection which is a direct violation of the Manual of Patent Examination Procedure’s statement that this is improper and should not be done. See, in this regard, MPEP § 706.02. Applicant respectfully requests that the Examiner select the single best one of the two primary applied references and apply only one of

them in this rejection.

Applicant notes that neither of the two base primary references, i.e., Shin or Katagiri, discloses the claimed invention. The Office Action admits that Shin's rotor 510 does not disclose the claimed groove/channel feature recited in the claims, and admits that Katagiri's rotor 3 also does not disclose the claimed groove/channel feature.

In an attempt to remedy these admitted deficiencies of Shin or Katagiri, the Office Action turns to Ogasawala, which does not disclose the claimed groove/channel feature either. The "claimed groove/channel feature" recited in claims 1 and 6 includes (1) a rotor having a guide groove located in its topside and provided to leave a predetermined interval from an outside of the stator, and (2) a frame having fixing means extending inward to fit into the guide groove for fixing the rotor.

Ogasawala does not disclose these positively recited features. Instead, Ogasawala's relied upon Fig. 7 discloses an outer upper edge frame 10a that is curled to form a holding flange 20' extending along the entire circumference of the cylindrical wall frame 10a of yoke 10 to be brought into pressure engagement with the upper surface of an annular magnet holding plate 17 (col. 3, lines 37-68). Ogasawala's Fig. 7 does not appear to disclose any guide groove into which frame fixing means 20' fits.

In other words, instead of providing a guide groove and a frame fixing means that fits into the guide groove in the rotor, Ogasawala employs an outer frame 10a that has flanges 20' that is brought into pressure engagement not with a groove, as recited, but with a flat plate 17.

In other words, Ogasawala's pressure flange works not with the claimed fixing means

extending inward to fit in a guide groove, and does not use or need a guide groove, and thus does not suggest use of a guide groove, because it is a flange 20' that abuts a flat plate 17 with a pressure engagement characteristic.

Thus, no matter how Ogasawala is used to modify either base reference, neither base reference when modified by Ogasawala will disclose, suggest or otherwise render obvious the claimed invention.

In other words, even if it were obvious to modify either of the two primary references in view of Ogasawala (which has not been demonstrated to be the case by any objective factual evidence) neither of the modified versions of the two base references would render obvious the claimed invention because none of the applied references discloses the claimed guide groove and fixing means fit into the guide groove.

Moreover, neither base reference has a rotor structure that needs to have a guide groove to work properly, and the Office Action does not present any objective factual evidence to support a conclusion that either base reference's rotor needs reinforcing or fortifying or would work any better if it were reinforced or fortified by providing either reference's rotor with Ogasawala's pressure flange 20'.

Accordingly, Applicant respectfully submits that the Office Action fails to provide a *prima facie* case of obviousness of the claimed invention.

Reconsideration and withdrawal of this rejection of claims 1, 5, 6 and 10 are respectfully requested.

Additional Cited Reference

Because the remaining reference cited by the Examiner has not been utilized to reject the claims, but has merely been cited to show the state of the art, no comment need be made with respect thereto.

Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone Robert J. Webster, Registration No. 39,538, at (703) 205-8076, in the Washington, D.C. area.

Prompt and favorable consideration of this Amendment is respectfully requested.

Application No.: 10/721,357
Reply to May 18, 2007 Office Action

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If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Dated: September 10, 2007

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By: 

James T. Eller, Jr.

Reg. No.: 39,538

BIRCH, STEWART, KOLASCH & BIRCH, LLP

8110 Gatehouse Road

P.O. Box 747

Falls Church, Virginia 22040-0747

Telephone (703)205-8000

Attorney for Applicant

JTE/RJW/amm 